

Applicant: Dan Mielke, et al
Serial No. 09/760,314
September 22, 2003

REMARKS/ARGUMENTS

Applicant thanks the Examiner for his time in the interview taking place on September 10, 2003. Pursuant to 37 C.F.R. §1.111, reconsideration of the instant application, as amended herewith, is respectfully requested. Entry of the amendment is also requested.

Claims 1-18 and 21-27 are presently pending before the Office. Claims 19 and 20 were withdrawn from further consideration pursuant to 37 C.F.R. 1.142(b). Examiner has rejected claims 1-10, 12 and 21-27. Applicant appreciates the Examiner's statement in the previous Office Action that claims 11 and 13-18 would be allowable if rewritten in independent form. New claims 28 through 34 are added and are rewritten versions of these claims in compliance with Examiner's statements, and allowance is earnestly requested for these claims. Revisions to claim 4 and 17 are to provide consistency in the claim language to clarify the claims to the Examiner.

The Examiner's Action and the references cited therein have been carefully studied by Applicant and the undersigned counsel. The amendments appearing above and these explanatory remarks are believed to be fully responsive to the Action. Accordingly, this important patent application is believed to be in condition for allowance.

NEW MATTER REJECTION

Relying on 35 U.S.C. §132, the Examiner has required the cancellation of the additions to the specification and drawings regarding Figures 5 and 6 as being new matter which is not

Applicant: Dan Mielke, et al
Serial No. 09/760,314
September 22, 2003

supported by the original disclosure. Applicant respectfully traverses the rejection and requests reconsideration.

As stated by the Circuit Court of Patent Appeals, "'New matter' is a technical legal term in patent law – a term of art. Its meaning has never been clearly defined for it cannot be.... We have to decide on a case-by-case basis what changes are prohibited as 'new matter' and what changes are not." In re Oda, 170 USPQ 268, 270-71 (C.C.P.A. 1971). An applicant is permitted to amend an application to include features of the claims or drawings to enhance the clarity of the application. Also, the disclosure may be amended to include matter that is inherently disclosed by the original application. In re Nathan, 140 USPQ 601, 604 (C.C.P.A. 1964). This is especially true where the need for clarification is based upon the requirements of the Examiner. Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc., 334 F.3d 1294, 1303-1304 (Fed. Cir. 2003).

The fundamental inquiry is whether the material added by amendment was inherently contained in the original application. Schering Corp. v. Amgen Inc., 222 F.3d 1347, 1352 (Fed. Cir. 2000). "To avoid the new matter prohibition, an applicant must show that its original application supports the amended matter." Id.

It is respectfully submitted that the added description and drawings to the specification fully comply with 35 U.S.C. §132. The description and drawings generally describe a particular embodiment properly described in the original specification and claims.

As discussed in the Examiner Interview, Figures 5 and 6 merely illustrate the final product of the method as described in the original claims after it has been performed. The

Applicant: Dan Mielke, et al
Serial No. 09/760,314
September 22, 2003

provision of the drawing of the cross section merely clarifies the formation of the structural bond produced by the adhesive after completion of the method. Moreover, each of the elements in the amended specification is discussed in original claims. The top skin coat (402), the bottom skin coat (404), the top mating portion (406), the bottom mating portion (408), and the structural adhesive (500) and the cavity (410) are all described in claim 1, as well all of the claims dependent thereupon.

Furthermore, the subject matter of the new specification and drawings, as well as the new claims, is found throughout the original specification. Support for the amendments and the new claims can be found throughout the specification as originally filed, especially at page 10, line 13 through page 11, line 17. Furthermore, the original claim language of the independent claims encompasses the limitations which have been added herein. Moreover, the drawings in Figures 5 and 6, and the added text to the specification cannot be new matter as they are merely illustrative of the method which is claimed herein. Applicant is not intending in any manner to narrow the scope of the claims.

Therefore, no new matter has been added to the application. Also, no estoppel should apply to this amendment. Withdrawal of the rejection is respectfully requested.

OBVIOUSNESS REJECTION

Relying on 35 U.S.C. §103(a), the Examiner has rejected the subject matter of claims 1-4, 6, and 22-27 as obvious over Graham et al. ("Graham") in view of Hordis. Applicant respectfully traverses the rejection and requests reconsideration. The Examiner submits that the adhesive is

Applicant: Dan Mielke, et al
Serial No. 09/760,314
September 22, 2003

structural "because it connects the inner and outer transom walls." However, such is not the case. The adhesive in fact does much more. As a structural adhesive, the adhesive forms a bond such that the adhesive itself physically becomes part of the structure of the unitary hull piece formed by the method. Neither Graham nor Hordis include this type of formation of a unitary hull structure. Moreover, Hordis does not concern hull formation at all. Hordis merely teaches the gluing of a transom to an otherwise already formed inner and outer hull.

On the other hand, the present invention, as found in the amended claims, teaches a new efficient method for forming a complete boat hull within closed molds. Moreover, as discussed in the Examiner Interview, the completed hull importantly does not require added reinforcing stringers located within the hull of the boat to be used as structural reinforcements. It is the foam which is injected within the cavity formed which forms a structural element that acts as a reinforcement of the boat hull.

Also, the structural adhesive between the upper portion and the lower portion of the hull, in forming part of the unitary hull piece, permits a higher internal pressure from the injected foam. It is evident that Applicant's invention is decidedly different from the teachings of Graham and Hordis. Graham does not suggest or even mention the creation of a structural bond. In fact, Graham does not suggest or teach the creation or use of any adhesive between the top portion and the bottom portion of the piece to form cavities to be filled with foam to act as structural reinforcements.

Applicant: Dan Mielke, et al
Serial No. 09/760,314
September 22, 2003

The Examiner notes that the Hordis patent does not teach or suggest the use of stringers. However, stringers are used inside the hull of a boat and are not needed in a mere transom invention. The present invention relates to the creation of entire boat hulls within a closed mold. These hulls have elongated foam-filled cavities which not only add to the buoyancy, but obviate the need for structural stringers. This subject matter is decidedly different from the mere addition of a transom to a pre-formed boat hull. Since Hordis merely addresses a method for forming a transom, Hordis in fact is not pertinent prior art with regard to the question of stringers at all.

Clearly, there is an absence of any suggestion or teaching to use a structural adhesive to form a structural bond at all. Moreover, there is no teaching of a structural bond for relieving stress from foam within the hull, or to use methacrylate compound. One skilled in the art certainly could not find ample motivation to use the teachings of Graham and Hordis to arrive at the present invention. There can be no motivation to combine the prior art to produce the structural bond to reduce or eliminate the need for stringers since Hordis does not even address the problem addressed by the present invention. Thus, this rejection is respectfully traversed and allowance of the claims is earnestly solicited.

The Examiner has also rejected the subject matter of claims 5 and 21 as obvious over Graham et al. ("Graham") in view of a new reference Waldock. Applicant respectfully traverses the rejection and requests reconsideration of the claims as amended. The Examiner notes that Waldock discloses the use of methacrylate adhesive to secure portions of a boat hull. However, this is not the case.

Applicant: Dan Mielke, et al
Serial No. 09/760,314
September 22, 2003

Waldock in fact teaches away from the use of a structural adhesive to form a unitary hull piece. Waldock clearly teaches the gluing of structural frame members (90) to the hull (26) for placement between the hull (26) and the deck (50). See Figure 3, and Col. 8, l. 60 to Col. 9, l. 4. Moreover, the brackets (92) required in Waldock specifically teach away from the use of a structural adhesive alone to form part of the hull, as found in the present invention. Among other advantages, the present invention's method is therefore more efficient, requires fewer parts and assembly steps, and is cheaper in parts and labor than is taught by Graham and Waldock.

Moreover, Waldock's inclusion of structural members teaches away from the present invention, since the present invention teaches a method which renders the use of structural members within a hull obsolete. Accordingly, Applicant respectfully submits that claims 5 and 21 are also patentable as amended over the Graham and Waldock references under 35 U.S.C. §103. Withdrawal of the rejection is respectfully requested.

The Examiner has also rejected the subject matter of claims 7-10 and 12 as obvious over Graham et al. ("Graham") in view of Hordis and Kurtz. Applicant respectfully traverses and seeks reconsideration and withdrawal of this rejection. For the reasons discussed above, the rejections of underlying independent claims to these claims based upon these references have been traversed. Furthermore, Kurtz is merely a reference for a synthetic resin product, and does not teach a method for forming a boat hull within closed molds at all. There is no teaching or suggestion that this adhesive would be advantageous in the use of a closed-mold formation

Applicant: Dan Mielke, et al
Serial No. 09/760,314
September 22, 2003

process. Therefore, these claims are also respectfully traversed, and reconsideration and withdrawal of the rejection is respectfully requested.

One of ordinary skill in the field of this invention at the time this invention was made would not have selected from the prior art the specific references cited by the Office, because the prior art is as vast as technology itself; the cited references were excised from the corpus of the prior art only after Applicant's invention had been disclosed. Thus, the Office had a decided advantage over those of ordinary skill in the art, since they, like Applicant, were confronted with the prior art taken as a whole, not just the patents awarded to Graham, Waldock, Hordis and Kurtz. See Panduit Corp. v. Dennison Mfg. Co., 810 F.2d at 1577, 1 U.S.P.Q.2d at 1605 (Fed. Cir. 1987).

CONCLUSION

Even though the initial claims in this important patent application were drawn to a new, useful and nonobvious invention, they have now been amended to increase their specificity of language. Applicant respectfully submits that claims 1-18 and 21-34 are patentable over the art of record. Applicant further submits that on the basis of Examiner's objections in the prior Office Action, claims 11 and 13-18 are now in condition for Allowance. Moreover, since the original scope of the claims is not narrowed by these amendments, no estoppel has been created.

A Notice of Allowance for all of the claims submitted herein is earnestly solicited.

Applicant: Dan Mielke, et al
Serial No. 09/760,314
September 22, 2003

If the Office is not fully persuaded as to the merits of Applicant's position, or if an Examiner's Amendment would place the pending claims in condition for allowance, a telephone call to the undersigned at (954) 763-3303 would be appreciated.

If there are any additional charges, including extension of time, please bill our Deposit Account No. 13-1130.

Respectfully submitted,



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